

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed January 21, 2010. Through this response, claims 1, 8, 10, 24, 47, 49, 59, 76-78, 80-82, 84, 114, and 115 have been amended, and claims 25, 36-46, 75, and 85-97 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-16, 20-24, 27-35, 47-65, 68-74, 76-84, and 112-116 are respectfully requested.

#### **I. Claim Rejections under 35 U.S.C. §112**

Claim 49 has been rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Applicant has amended claim 49 based on the specification at least found on pages 9 – 12, previously presented (now-canceled) claims 75, 85, and 90, and figure 5 of the drawings as originally filed. Applicant believes the rejection to be rendered moot, and respectfully requests that the rejection be withdrawn.

#### **II. Claim Rejections under 35 U.S.C. §101**

Claims 49-65 and 66-97 have been rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. Applicant has amended claims 49 and 59, and has canceled without prejudice, waiver, or disclaimer claims 85-97. Applicant believes the rejection to be rendered moot, and respectfully requests that the rejection be withdrawn.

#### **III. Claim Rejections under 35 U.S.C. §103(a)**

##### **A. Statement of the Rejection**

1. Claims 1-16, 20-24, 27-45, 49-65, 69-73, 75-94 and 112-116 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ukai et al.* ("Ukai," U.S. Patent No. 7,096,486) in view of *Herz et al.* ("Herz," U.S. Patent No. 5,758,257).

2. Claims 25 and 74 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ukai* in view of *Herz* in further view of *Alexander et al.* ("*Alexander*," U.S. Patent No. 6,177,931).

3. Claims 46-48 and 95-97 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ukai* in view of *Herz* in further view of *Block et al.* ("*Block*," U.S. Patent No. 6,675,384).

Applicant respectfully traverse these rejections to the extent not rendered moot by amendment.

#### **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicant respectfully submits that a *prima facie* case of obviousness is not established using the art of record.

1. Claims 1-16, 20-24, 27-45, 49-65, 69-73, 75-94 and 112-116 - 35 U.S.C. § 103(a) – *Ukai* in view of *Herz*.

*(a) Claims 1-16, 20-24, 27-35, and 112-113:*

Applicant has amended independent claim 1 to incorporate features found in previous claims 44-46, now canceled. In view of these amendments, Applicant respectfully submits that the amendments to claim 1 have rendered the rejection moot. Additionally, Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Ukai* in view of *Herz* fails to disclose, teach, or suggest at least the claim features of “receiving user input requesting television functionality subsequent to determining the overall user preference score, where the television functionality comprises tuning to a user identified television service, where the user identified television service corresponds to at least one of the plurality of viewing parameters; and providing the user with a result that is responsive to the user input and to the overall user preference score, **where the result comprises not tuning to the user identified television service.**” The non-final Office Action (page 17) addresses the features found in previously presented in claim 46, yet alleges that “*Ukai* and *Herz* disclose all of the claim limitations in claims 45-47, respectively, but fail to teach a conditional access system that will not tune to a program selection unless a user enters his/her PIN/password.” Since the rejection appears to combine features among several claims, some of which are not found in claim 1, Applicant will address patentability of the claim in view of the addition of *Block* in a subsequent section of the response. For the present ground of rejection, Applicant respectfully submits that *Ukai* in view of *Herz* fails to disclose a method where the DHCT determines an overall user preference score according to the features of claim 1, and subsequently denies a user’s request to tune to a service. Accordingly, Applicant respectfully requests that the rejection be withdrawn and claim 1 allowed.

Because independent claim 1 is allowable over *Ukai* in view of *Herz*, dependent claims 2-16, 20-24, 27-35, and 112-113 are allowable as a matter of law for at least the reason that the

dependent claims 2-16, 20-24, 27-35, and 112-113 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

(b) *Claims 49-65, 69-73, 76-84 and 114-115*

Applicant has amended independent claim 49 to incorporate features found in previous claims 75, 85, and 90, now canceled. In view of these amendments, Applicant respectfully submits that the amendments to claim 49 have rendered the rejection moot. Additionally, Applicant respectfully submits that independent claim 49, as amended, is allowable for at least the reason that *Ukai* in view of *Herz* fails to disclose, teach, or suggest at least the claim features of “receive user input requesting television functionality subsequent to the determination of the overall user preference score, where the television functionality comprises presenting for display an interactive program guide (IPG); and ***provide the user with a result that is responsive to the user input and to the overall user preference score, where the result comprises presenting an initial IPG screen that lists at least one television service that corresponds to at least one of the plurality of viewing parameters, where the initial IPG screen omits television services that do not correspond at least one of the plurality of viewing parameters, where the initial IPG screen comprises plural rows of television services and plural columns of equal-lengthed intervals, wherein each respective start of the equal-lengthed intervals corresponds to a scheduled broadcast time for plural television programs.***” The non-final Office Action (page 15) indirectly refers to the rejection of claim 41, which is part of a broad rejection addressing claims 36-41 (see page 14). In particular, the rejection encompassing claim 41 refers to Figures 17, 21, 25-26, and column 14, line 45 – col.18, line 7 of *Ukai*. None of the figures, nor sections cited above from *Ukai*, discloses, teaches, or suggests at least the above-emphasized claim 49 features. *Herz* does not cure the deficiencies of *Ukai*. Accordingly, Applicant respectfully requests that the rejection be withdrawn and claim 49 allowed.

Because independent claim 49 is allowable over *Ukai* in view of *Herz*, dependent claims 50-65, 69-73, 76-84 and 114-115 are allowable as a matter of law.

(c) *Claim 116*

Applicant respectfully submits that independent claim 116 is allowable for at least the reason that *Ukai* in view of *Herz* fails to disclose, teach, or suggest at least the claim features of "tracking a plurality of viewing parameters corresponding to services that are provided to a user, at least a first portion of the viewing parameters overlapping in content a second portion of the viewing parameters, ***the viewing parameters comprising a television service, a type of television service, a television instance, and a type of television instance.***" The non-final Office Action (page 16) equates each of the above-emphasized parameters in a manner that is inconsistent with Applicant's disclosure, contrary to Federal case law which requires (from MPEP 2111) the following:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

415 F.3d at 1316, 75 USPQ2d at 1329. See also< *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

The non-final Office Action appears to equate "X TIME" to both a service and a television instance. This interpretation is inconsistent with Applicant's specification, and hence fails to

establish a *prima facie* rejection. Additionally, the non-final Office Action also incorrectly refers to the sound and language designation for “X TIME” as a television instance type, which likewise is inconsistent with Applicant’s specification. For at least the reasons set forth above, Applicant respectfully requests that the rejection be withdrawn and claim 116 allowed.

2. Claims 25 and 74 - 35 U.S.C. § 103(a) – *Ukai* in view of *Herz* in further view of *Alexander*.

Claim 25 has been canceled, hence rendering the rejection to claim 25 moot. In addition, with respect to claim 74 and as set forth above, *Ukai* in view of *Herz* fails to disclose, teach, or suggest at least the above-emphasized claim 49 features. *Alexander* does not cure the deficiencies of *Ukai* and *Herz*. For at least the reason that claim 49 is allowable over *Ukai* in view of *Herz* in further view of *Alexander*, claim 74 is allowable as a matter of law and hence Applicant respectfully requests that the rejection be withdrawn and claim 74 allowed.

3. Claims 46-48 and 95-97 - 35 U.S.C. § 103(a) – *Ukai* in view of *Herz* in further view of *Block*.

As indicated above, claims 95-97 have been canceled, hence rendering the rejection moot. Further, and with regard to claims 46-48, Applicant will address claim 46 in the context of claim 1 given its incorporation thereof. Applicant respectfully submits that *Ukai* in view of *Herz* in further view of *Block* fails to disclose, teach, or suggest at least the claim 1 features emphasized above in section 1. The non-final Office Action (page 17) refers to elements 100 and 110 in Figure 1 and column 14, lines 6-52 of *Block*, the latter which provides as follows:

The viewing control unit 100 can be used to supervise the content of incoming program signals and thus preferably includes a lock mechanism 310 for preventing the local information label LIL from being changed except with a personal identification number (PIN) or combination or physical key. According to one embodiment, the viewing control unit 100 includes a memory 320 for storing a master combination and an operating combination. The operating combination can be keyed in by a parent with a keypad 330 or remote control device to change the local audio and video category labels, for example. A comparator 340 in the viewing control unit 100 compares the operating combination stored in the

memory 320 with the combination entered via the keypad 330, and if they are equal, enables the local information label LIL to be changed. Knowledge of the master combination allows a user to change the operating combination stored in the memory 320. The master combination can be kept in a safe place by parents so that it can be used to change the operating combination in the event that the operating combination is lost.

According to another exemplary method, the master combination can be retained by the manufacturer, and the operating combination can be changed by knowledge of the operating combination. Initially, the operating combination can be set to 0000, for example. If the operating combination is forgotten, parents may call the manufacturer who can provide instructions as to how to reset the operating combination to 0000. In order to maintain the security of the reset procedure, the key strokes necessary to reset the operating combination to 0000 preferably change each time the master combination is reset.

According to a further embodiment, the lock mechanism 310 can be a physical lock and key, for example made of metal or plastic. By inserting the key into the lock, parents can reset the operating combination to 0000.

The lock mechanism 310 thus preferably allows a user to change or input the local information label LIL only after entering the appropriate combination or PIN via the remote control. After keying in the correct PIN, the user, according to an exemplary embodiment next presses a specified button on the remote control to access the audio category labels, and increments or decrements the values with the audio volume control buttons, for example. The video category labels may be accessed with a different button and changed, for example, with the channel selector on the remote control. Other labels may be accessed and changed in a similar manner.

Applicant respectfully submits that the above-reproduced portion from *Block* fails to cure the deficiencies of *Ukai* in view of *Herz*. In claim 1, the user has requested the tuning of a desired program that meets the preferences of the user, and yet is denied. No such scenario is present in the above-reproduced section of *Block*, but rather, a deliberate attempt to deny access to content (see, e.g., col. 2, lines 1-6, *Block*). For at least this reason, Applicant respectfully requests that the rejection be withdrawn and claim 1 allowed.

Further, the combination is not obvious – *Ukai* discloses nothing about such constraints, and its use or teachings thereof in this combination are not obvious. Though *Herz* does appear to disclose parental controls (see, e.g., col. 46, *Herz*), such controls are for locking out others, not the user whom requested the programming and for whom the preference engine is

performing the method of claim 1. The alleged motivation for combining *Ukai*, *Herz*, and *Block* (page 17, non-final Office Action) alleges “for the purpose of providing a means for users to gain by being able to make informed choices.” The broad, universal concept of making informed decisions does not rise to the level of articulated reasoning required to combine such disparate systems as *Block*, *Ukai* and *Herz*. For at least this additional reason, Applicant respectfully requests that the rejection be withdrawn and claim 1 allowed.

Because independent claim 1 is allowable over *Ukai* in view of *Herz* and further in view of *Block*, dependent claims 47-48 are allowable as a matter of law.

#### **IV. Canceled Claims**

As identified above, claims 25, 36-46, 75, and 85-97 have been canceled from the application through this response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.



**CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-16, 20-24, 27-35, 47-65, 68-74, 76-84, and 112-116 be allowed to issue. Any statements in the non-final Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all allegations of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the final Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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